

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 56

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW J. DATON-LOVETT

Appeal No. 1999-0738
Application No. 08/474,195

HEARD: Nov. 28, 2000

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

Andrew J. Daton-Lovett appeals from the examiner's final rejection of claims 1-4, 15 and 19. Claims 5-14, 16-18, 20 and 21 stand withdrawn from consideration under 37 CFR § 1.142(b) as not being readable on the elected species. No other claims are currently pending.

We reverse.

Appeal No. 1999-0738
Application No. 08/474,195

Appellant's invention "relates to an elongate hollow element arranged to be progressively flattened and wound into a compressed condition about one or more axes extending transversely relative to the longitudinal extent of the element" (specification, page 1). A further understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears in the appendix to appellant's main brief.

The references of record relied upon by the examiner as evidence of anticipation are:

Myer	3,357,457	Dec. 12, 1967
Groskopfs	3,434,674	Mar. 25, 1969

Claims 1-4, 15¹ and 19 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a disclosure that "fail[s] to provide an adequate written description of the invention" (answer, page 4).

Claims 1-4 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Myer.

¹Claim 15 is a multiple dependent claim that depends from claim 1, claim 5 or claim 9. Accordingly, the examiner's various rejections of "claim 15" is understood to only be directed to claim 15/1, that is, claim 15 as it depends from claim 1.

Appeal No. 1999-0738
Application No. 08/474,195

Claims 1, 4, 15 and 19 stand rejected under 35 U.S.C.
§ 102(b) as being anticipated by Groskopfs.

Reference is made to appellant's main and reply briefs
(Paper Nos. 45 and 49) and to the examiner's answer (Paper No.
48) for the respective positions of appellant and the examiner
regarding the merits of these rejections.

Discussion

The rejection under 35 U.S.C. § 112, first paragraph

The written description and enablement requirements found
in the first paragraph of 35 U.S.C. § 112 are separate and
distinct. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19
USPQ2d 1111, 1117 (Fed. Cir. 1991).

In setting forth on page 5 of the answer the reasons for
the standing rejection under 35 U.S.C. § 112, the examiner
states:

. . . [I]t is noted that the disclosure on page 4
does not fully disclose the invention *to enable* one
to make and use the invention. The specification
does not explain *how* each layer retains its bias
characteristic when bonded together. In other
words, when the two opposed biased layers [are]
affixed together, either the inner layer would keep
the outer layer from forming a tubular
configuration, or the inner layer would loose [sic,

lose] its bias feature and adopt the bias feature of the outer layer, or the biasing forces of the two layers would simply cancel one another out to render the elongated element biasless. Furthermore, the disclosure on page 21 does not fully explain *how* the element can be wound around a plurality of axes. These issues indicate that the specification would not have taught one skilled in the art *how to make and/or use* the full scope of the claimed invention without undue experimentation. [Answer, page 5; emphasis added].

Thus, while the examiner's statement of the rejection on page 4 of the answer would appear to indicate that the standing rejection under § 112 is based on a failure of the disclosure to meet the written description requirement of the first paragraph of the statute, the explanation of the rejection on page 5 of the answer makes clear that the rejection is in fact based on the enablement requirement of § 112.

The dispositive issue with regard to the enablement requirement is whether appellant's disclosure, considering the level of ordinary skill in the art as of the date of appellant's application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation. *In re Strahilevitz*, 668 F.2d 1229, 1232, 212

USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of appellant's disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. *Id.* In the present case, the examiner has failed to meet this burden.

A person of ordinary skill in the art would have readily appreciated from appellant's disclosure² that the bi-stable characteristic of appellant's device is the result of the bias of one of the layers of the composite structure being *temporarily* overcome by the bias of the other layer to hold the device in one of its two stable positions, rather than the bias of one of the layers being "lost" as a result of that layer's bias being less than the biasing force of the other layer. Further, we are in accord with appellant that the ordinarily skilled artisan would fully understand from appellant's disclosure³ how to wind the composite structure about a plurality of transverse parallel axes, for example, by

²See, for example, page 10, line 17 through page 11, line 22, and page 12, line 7 through page 13, line 7, of the specification.

³See, for example, page 21, lines 20 through 23, of the specification.

Appeal No. 1999-0738
Application No. 08/474,195

winding it into a coil from both ends. In short, the examiner has not advanced any reason, nor is any apparent to us, why a person of ordinary skill in the art, as of the date of appellant's application, would not have been able to make and use the device as claimed without undue experimentation.

Accordingly, we will not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claims 1-4, 15 and 19.

The rejections under 35 U.S.C. § 102(b)

It is well established patent law that for a reference to anticipate a claim, each and every element of the rejected claim must be found either expressly described or under the principles of inherency in the applied reference. *See, inter alia, RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It follows that the absence from the reference of any element of the claim negates anticipation of that claim by the reference. *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1034 (1987).

Considering first the § 102 rejection of claim 1 as being anticipated by Myer, the only embodiment of Myer that

reasonably appears to comprise two laminated layers affixed together to form a unitary composite element, as called for in independent claim 1, is the Figure 4 embodiment. Myer's Figure 4 embodiment is not disclosed as being stable in both the elongate hollow form and the compressed, wound form, as now claimed. Further, while Myer's Figure 4 embodiment comprises a first layer that is biased to an elongate hollow form, it does not further comprise a second layer that opposes the bias of the first layer, as now claimed. In this regard, the circumstance that the seam of the outer layer 24 is located on the opposite side of the hollow form relative to the seam of the inner layer 25 does not suffice.

In light of the foregoing, we will not sustain the standing § 102 rejection of claim 1 based on Myer, nor the standing § 102 rejection claims 2-4 and 15, which depend therefrom.

Turning to the § 102 rejection of claims 1 and 19 as being anticipated by Groskopf, the extensible tube disclosed therein is deficient in at least three respects. First, the extensible member of Groskopf does not comprise first and

second laminated layers affixed together, as the terms "laminated" and "affixed together" would be interpreted by an artisan when read in light of appellant's disclosure. The examiner's assertion that the strips 10, 12 of Groskopf's "could be adhered to each other by friction to form a laminated structure" (answer, page 6) has no factual support, and in any case would not meet the terms of the claims. Second, the extensible member of Groskopf's is not stable in both the elongate hollow form and the compressed, wound form, as claimed. In this regard, note column 7, lines 63-67, of Groskopf's ("The extensible member of the invention is suited to the three normal types of operation . . . self extension using the stored spring energy in the extensible member where there is no requirement for retraction . . ."). Third, the second strip or layer of Groskopf's is not arranged to oppose the bias of the substrate (i.e., first strip or layer) in the sense called for in the claims. In the claimed device, the first layer is biased to the elongate hollow form and the second layer is arranged to oppose that bias *upon adoption of the compressed, wound form*. In contrast, while the strips 10, 12 of Groskopf's are arranged "front to front" to "oppose and

Appeal No. 1999-0738
Application No. 08/474,195

cancel one another" (column 7, lines 30-43), this opposition occurs upon adoption of the deployed extensible form rather than upon adoption of the compressed, wound form. This difference is highlighted by Groskopfs' preference for storing the strips 10, 12 on separate storage spools (see Figure 10, column 5, lines 11-19, and column 6, lines 52-62), which storage arrangement would obviously preclude one strip from offering any opposition whatsoever to the other strip in the wound form.

For these reasons, we will not sustain the standing § 102 rejection of claims 1 and 19 based on Groskopfs, nor the standing § 102 rejection of claims 4 and 15 which depend from claim 1.

Appeal No. 1999-0738
Application No. 08/474,195

Conclusion

The decision of the examiner finally rejecting the
appealed claim is reversed.

REVERSED

	Irwin Charles Cohen)	
	Administrative Patent Judge)	
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)	
)	
	Lawrence J. Staab)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Jeffrey V. Nase)	
	Administrative Patent Judge)	

LJS:tdl

Appeal No. 1999-0738
Application No. 08/474,195

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